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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,353	02/10/2004	Phillip Frederick	10557/293163	1160

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EXAMINER
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SWIGER III, JAMES L

ART UNIT	PAPER NUMBER
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3733

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/775,353

Applicant(s)

FREDERICK ET AL.

Examiner

James L. Swiger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 13-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/24/04; 11/16/05.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12, drawn to an apparatus, classified in class 606, subclass 81.
- II. Claims 13-23, drawn to a method, classified in class 623, subclass 22.21.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed could be used to expand an intramedullary canal instead of use in a hip or shoulder joint.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Elena S. Polovnikova on 3/3/2006 a provisional election was made without traverse to prosecute the invention of the reamer apparatus, claims 1-12. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13-23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

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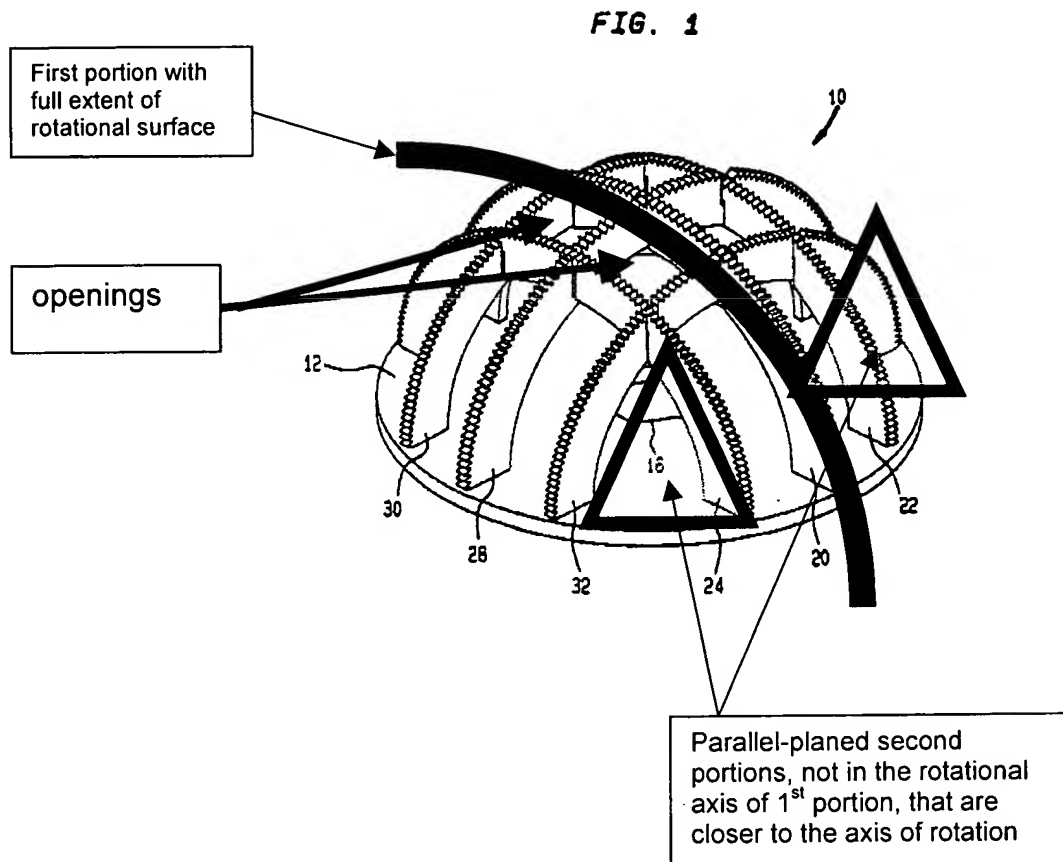
or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Frieze et al. (US 5,775,719). Frieze et al. disclose a reamer having a hollow body having a general dome shape (10) forming an inner and outer surface, and is capable of rotating on an axis (16). The device also has a plurality of raised edges for cutting bone (42) or cartilage, and a plurality of openings for the passing the fragments into the interior portion of the reamer (see drawing below). Also shown below is the reamer disclosed by Frieze et al. having a first portion dimensioned as a surface of rotation, and a second portion not forming a surface of rotation that is generally located closer to the axis of rotation than the first portion. For clarification, the triangular sections represent a portion of the reamer head that may be considered a second portion, separate from the shown first "banded" and rotational portion. These two portions are closer to the location of the axis of rotation (16), than from the extents of the first portion as a rotational surface. Though difficult to show, the two triangles are in planes substantially parallel.



Further, with regards to claim 8, the device of Frieze et al. is capable of use in surgery for either hip replacement or in the acetabulum of an animal or a human.

Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Lechot (US 2005/0075639). Lechot discloses a device having a hollow body with a surface (12'), a dome shape (fig. 4), a plurality of raised edges for cutting bone or cartilage (fig. 4), and has a plurality of openings for passing fragments of bone into the interior of the reamer (18'). Lechot further discloses a reamer that has a first portion (12') and that also has a second portion (50) that does not form a surface of rotation and is closer to the axis of rotation (since these cut edges form a shortened outer rim of the reamer, closer to the axis). See also Par. 0033. The two second portions are substantially

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parallel, and the raised cutting edges are also confined to the first portion (fig. 4). The device as disclosed is also capable of use in hip replacement arthroplasty or for use in the acetabulum of an animal or human. Also in the device of Lechot, the raised edges may be considered in multiple sectors, divided transversely across the first portion, or horizontally across its diameter, as individual or multiple cutting edges.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lechot '639 in view of Salyer (US 5,116,165). Lechot discloses the claimed invention except for the cutting edges being confined to a band in the middle portion of the dome shape (e.g. the first portion). Salyer discloses a reamer that has cutting edges placed on the cutting surface in a band-like formation, wherein each cutting surface overlaps the previous one in a particular cutting direction, considered form and function as a band of cutting edges (Fig. 2; Col. 3, lines 30-44; Col. 4, lines 19-24). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Lechot having raised edges in a band formation in the center of the domed surface in view of Salyer to more effectively cut the bone or cartilage in use of the device.

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James L. Swiger whose telephone number is 571-272-5557. The examiner can normally be reached on Monday through Friday, 8:30am to 5pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLS



3/3/2006



EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER